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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,534	07/31/2001	MaKolle Williams	WIL003USPT01	4890

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EXAMINER

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ART UNIT PAPER NUMBER

3726

DATE MAILED: 04/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/919,534

Applicant(s)

WILLIAMS, MAKOLLE

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 6, 8, 9, 10, and 12-28** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites “the first flange” in the last two lines which lacks proper antecedent basis.

Claim 10 recites “distal ends” in line 2 which lacks proper antecedent basis.

Claim 12 recites “the tube-receiving frame” in lines 6-7 which lacks proper antecedent basis.

Claim 17 recites “the spherical member” in line 1 and “the receiving member” in line 2 which lacks proper antecedent basis.

Claim 18 recites “the spherical member” in line 2 and “the receiving member” in line 3 which lacks proper antecedent basis.

Claim 19 recites “the spherical member” in line 1 and “the receiving member” in line 2 which lacks proper antecedent basis.

Claim 20 recites “the spherical member” in line 2 and “the receiving member” in line 3 which lacks proper antecedent basis.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

4. **Claims 1-28** are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

This application was filed as a C.I.P. application of parent case 09/490,417 ('417). In the '417 application, Samuel Karsten was the original sole inventor when the '417 application was filed on 1/24/00. A signed statement under 37 C.F.R. 1.48(a)(1) adding Makolle R. Williams (signature date 5/7/00) as an inventor and a new declaration signed by both Makolle R. Williams (signature date 5/7/00) and Samuel Karsten (5/7/00) was later filed (paper #4). A protest (paper #5, dated 9/10/00) was then filed by Makolle R. Williams who claims to be the sole inventor. In the protest papers, there is an attached letter (dated 7/19/00) to Timothy Czaja from Z. Peter Sawicki stating that "Mr. Williams does not want to pursue the patent application that was filed on January 24,2000" and that "...Mr. Williams will be filing the enclosed Revocation and Power of Attorney to the application that was filed on January 24, 2000." It appears that Makolle

R. Williams initially wanted to be a joint inventor with Samuel Karsten, then Mr. Williams changed his mind and wants to be considered the sole inventor, finally, Mr. Williams wanted to be removed as an inventor. However, there is no record of a Revocation and Power of Attorney to remove Mr. Williams as an inventor in the '417 after being granted co-inventorship with Mr. Karsten.

Therefore, claims 1-28 are rejected under 35 U.S.C. 102(f) because the record of the '417 application is not clear as to who is the actual inventor. It does not appear that the true inventorship in the '417 application has been fully resolved. If Mr. Williams did in fact file a Revocation and Power of Attorney (which has not yet been received) to remove Mr. Williams as an inventor in the '417 application, then Mr. Karsten is the sole inventor. If Mr. Karsten is the sole inventor of the '417 application, the current application is an improper C.I.P. because common inventorship must exist in the parent application ('417) to claim benefit of the '417 application. Finally, if Mr. Karsten is the sole inventor of the '417 application, Mr. Williams did not invent the claimed subject matter under 35 U.S.C. 102(f) because he did not himself invent the subject matter to be sought to be patented.

In response to this office action, applicant is requested to clarify the following issues:

- (1) Are Mr. Karsten and Mr. Williams joint inventors of the '417 application?
- (2) Did Mr. Williams file a revocation and power of Attorney to be removed as an inventor and is Mr. Karsten the sole inventor of the '417 application? If Mr. Karsten is the sole inventor, this is an improper C.I.P. because there is no common inventorship in the parent application.
- (3) There was no response filed to the final rejection mailed 4/10/02 in the '417

application, did applicant intend to abandon the '417 application without filing a response? Because if no revocation and power of attorney was filed remove Mr. Williams as an inventor before abandonment of the '417 application, Mr. Karsten and Mr. Williams are joint inventors in the '417 application.

5. **Claims 1-28** are provisionally rejected under 35 U.S.C. 102(e)/(2) as being clearly anticipated by Karsten (US 2003/0009840 A1).

Fig. 3-5 are identical to the claimed invention.

This is a provisional 102(e) rejection if Mr. Williams filed a revocation and power of attorney to be removed as an inventor in the '417 application, which made Mr. Karsten the sole inventor of the '417 application, therefore, the claimed subject matter was invented by another under 35 U.S.C. 102(e).

Note: This application is a C.I.P of the '417 application with Mr. Williams as the sole inventor. Application no. 10/238,136, pub. no. US 2003/0009840 A1, pub. date Jan. 16, 2003 is also a C.I.P. of the '417 with Mr. Karsten as the sole inventor. The '136 application claims only new subject matter shown in fig. 6 (see pub. no. US 2003/0009840 A1). The instant application claims subject matter which is different from that claimed in the '136 application. Therefore, there cannot be a declaration of interference because the '136 application and the instant application claim different subject matter. Furthermore, there cannot be a declaration of interference between the '136 application and the instant application if both Mr. Williams and Mr. Karsten are co-inventors in the '417 application See MPEP 2300.

6. **Claims 12-16** are rejected under 35 U.S.C. 102(b) as being anticipated by Ampian (5,207,755).

Ampian teaches a paint roller comprising: a handle **12** having a first end and a second end, a shaft **14** having a first end and a second end, a functional element **22** secured to the second end of the shaft **14**, and attachment means **10** interposed between and connecting the second end of the handle **12** and the first end of the shaft **14** which is configured to selectively position the tube receiving frame **22** relative to the handle **12** by providing a disengaged condition permitting repositioning of the shaft **14** relative to the handle **12** in at least two degrees of freedom, and an engaged condition preventing repositioning of the shaft **14** relative to the handle, wherein the engaged condition can be achieved with the shaft **14** in at least two different positions relative to the handle **12**. The shaft **14** can be rotated at least 60 degrees and angularly repositioned relative to handle at least 120 degrees (col. 3, lines 46-47).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-11 and 17-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ampian (5,207,755) or Cayo (3,408,676) in view of Cline (365,329).

With respect to claims 1 and 17-20, Ampian teaches a paint roller comprising: a handle **12** having a first end and a second end, a shaft **14** having a first end and a second end, a functional element **22** secured to the second end of the shaft **14**, a flexure joint **10** interposed between and connecting the second end of the handle **12** and the first end of the shaft **14**, whereby the shaft is repositionable relative to the handle between a first locked position and a second locked position. Cayo also teaches a handle **7**, shaft **3**, functional element **1**, and flexure joint **5**.

Ampian or Cayo teaches the invention cited with the exception of having a spherical member, a receiving member configured and arranged to maintain and selectively engage the spherical member, and a connector in communication with the receiving member for releasably locking the spherical member in position as between a first locked position and a second locked position relative to the receiving member.

Cline teaches a handle **H** having a first end and a second end, a shaft **I** having a first end and a second end, a functional element (attached to threads) secured to the second end of the shaft **I**, a flexural joint **D** interposed between and connecting the second end of the handle **H** and the first end of the shaft **I**, which includes a spherical member **F**, a receiving member **E** configured to maintain and selectively engage the spherical member **F**, and a connector **G** in communication with the receiving member **E** for releasably locking the spherical member **F** in position as between a first locked position and a second locked position relative to the receiving member **E**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Ampian or Cayo with a spherical member, a receiving member



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configured and arranged to maintain and selectively engage the spherical member, and a connector in communication with the receiving member for releasably locking the spherical member in position as between a first locked position and a second locked position relative to the receiving member, in light of the teachings of Cline, in order to provide better incremental adjustment of the shaft relative to the handle.

Regarding claim 2, Ampian teaches that the tube receiving frame **22** rotatably secured to the second end of the shaft **14**.

Regarding claim 3, Cline teaches that the spherical member **F** is connected to the first end of the shaft **I** and the receiving member **E** is connected to the second end of the handle **H**.

Regarding claim 4, Cline teaches that the spherical member **F** is connected to the second end of the handle **H** via **C** and the receiving member **E** is connected to the first end of the shaft **I** via **F** and **J**.

Regarding claims 5, 22, 24, 26, and 28, Cline teaches that the connector **G** is hand operable for locking and releasing the spherical member **F**.

Regarding claims 6 and 7, Cline teaches that the spherical member **F** has a radius, the receiving member **E** has first and second arms **B,C**, the first arm **B** has an inner surface facing the second arm **C** and defines a depression having a circular periphery on the inner surface, the depression has a radius which is smaller than the radius of the spherical member **F**, and the spherical member **F** is sandwiched between the first and second arms **B,C** and centered within the depression through the first flange.

Regarding claims 8 and 9, Cline teaches the depression in the first arm **B** is an aperture (for **G**) extending completely through the first arm **B**.

Regarding claims 10 and 11, Cline teaches the connector **G** has a proximal end and a distal end with the distal end, with the distal end slidingly extending through a bore in one arm **B** and threadably engaging the other arm **C** so as to prevent passage of the connector **G**, completely through the bore, whereby tightening of the connector pulls the arms together to lock.

Regarding claims 21, 23, 25, and 27, Cline teaches that the shaft **I** is rotatable 360 degrees relative to the receiving member **E**.

### ***Contact Information***

9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

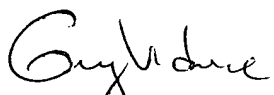
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MJ

March 22, 2003

  
**GREGORY VIDOVICH**  
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